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10/809,943	03/24/2004	Maria Theresa Barnes-Leon	384818043US01	6435

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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/809,943	Applicant(s) BARNES-LEON ET AL.	
	Examiner Jean M. Corrielus	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-45 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed August 8, 2005, in which claims 1-45 are presented for further examination.

Response to Arguments

2. Applicant's arguments filed August 8, 2005 have been fully considered but they are not persuasive. (See Examiner's remark).

Claim Objections

3. Claims 1 and 24 are objected to because of the following informalities: claims 1 and 24 recite "a second intermediate form". Applicant should duly note that one having ordinary skill in the art would have found impossible to convert the enterprise information in the first into a second intermediate form without first converting the enterprise information into a first intermediate form. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. Claims 25-45 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. It is, therefore, directed to non-statutory subject matter.

Claims 25-45 in view of **MPEP section 2106 IV.B.2. (b)** define non-statutory processes because they merely manipulate an abstract idea without a claimed limitation to a practical application. The language of the claim raises a question as to whether the claim is directed

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merely to an abstract idea, which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Thus, the claimed are rejected as being non-statutory. Additionally, the invention, as claimed, is directed to the manipulation of an abstract idea with no concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101 in the technology arts.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". Rubber-Tip Pencil Co. V. Howard, 20 wall. 498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basis tolls of scientific and technological work Gottschalk V. Benson, 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter Parker V. Flook, 197 USPQ 193, 201 (S Ct 1978). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Wamerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Claim 25 represents an abstract idea, which do not provide a practical application in the technological arts. There is no manipulation of data nor there any transformation of data from one state to another being performed in "A data structure for managing enterprise data" in claim 25. A data structure for managing enterprise data" is not a physical transformation. Thus, no physical transformation is performed, no practical application is found in the claims. Therefore, claim 25 is directed to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Applicant is advised to

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amend the claims by specifying the claim being directed to a practical application and producing a tangible result being executed by a general purpose computer in order to correct the above indicated deficiencies.

As to claims 26-45:

The dependent claims 26-45 are rejected for fully incorporating the errors of their respective base claims by dependency. Thus, claim 26-45 are merely abstract idea and are being processed without any links to a practical result in the technology arts.

Claim Rejections - 35 USC § 112.

5. Claims 25-45 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 25 recites a wide of limitations without providing a concrete and useful result in the technology art. It is unclear as to what the applicants try to accomplish. Managing enterprise data using data structure is not enable one having ordinary skilled in the art to make and use the claimed invention. The specification does not provide a clear description how to enable one skilled in art to make the claimed invention (see *In re Wand*, 858 F.2d 731, 737, 8 USPQ2d, 1400, 1404 (Fed. Cir 1998), MPEP 2164.01(a) and 2164.04). Applicants are advised to amend the claims to provide a structure and

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functional claimed language that produces a concrete and useful result in order to enable one having ordinary skill in the art to understand the claimed invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 3-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodamer et al., (hereinafter “Bodamer” US Patent 6,236,997 and Braud et al., (hereinafter “Braud”) US publication 2003/0023580.

As to claim 1 and 24, Braud discloses a health care system that transfers preumbra enterprise data from a plurality of disparate system to a requestor (section [0004], [0021]). Braud discloses the use of managing enterprise data by converting the content from the message data to enterprise information using the content conversion rules (section [0021]). However, Braud does not explicitly disclose the use of converting the enterprise information from a first and second form into a target form. On the other hand, Bodamer discloses the claimed “extracting enterprise information in a first form that is associated with a first source computerized system” accessing the foreign database (12 and 14) via a gateway (22) (fig. 1B); “converting the enterprise information in the first form into corresponding information that is in a second intermediate form” by translating data and SQL statements having the format of the database system (20) into formats that are recognizable by the foreign database system (col.2, lines 8-20; (fig.3B); and

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“converting the enterprise information in the second intermediate form into a target form that corresponds to a target computerized system, wherein the second intermediate form includes a plurality of common data type elements that are adapted to be shared across a plurality of data objects in the second intermediate form” wherein the gateway maps the data representation and functionality of one data source onto another data source by performing a translation of SQL statements from the database system (20) into a syntax recognizable by either the foreign database (12 and 14), wherein the gateway forwards the translated commands to the targeted foreign database, maps the resulting data from the targeted database into the format of the database system (col.2, lines 8-20; fig.3B). Bodamer does not explicitly disclose the use of managing enterprise data. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Braud’s system to incorporate the use of converting the enterprise information from a first and second form into a target form, in the same conventional manner as disclosed by Bodamer (col.2, lines 8-20; fig.3B). One having ordinary skill in the art would have found it motivated to use to such a modification for the purpose of minimizing the number of conversions, whereby no data is converted until it is needed in a specific format for processing.

As to claim 3, Bodamer discloses the claimed “a fault transformer input element and a fault transformer output element” (col.5, lines 12-20; col.20, lines 23-31)

As to claims 5, Bodamer discloses the claimed “an error type element” an error message is send if no information was selected in response to a user request (col.9, lines 29-32).

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As to claims 9 and 10, Bodamer discloses the claimed “a plurality of application type elements” four type of translation relates to the application program interface (col.7, lines 18-34).

As to claim 4 Braud discloses the claimed “an application instance name element” (section [0013], [0092]).

As to claim 6, Braud discloses the claimed “wherein the fault handler output element includes a message text element” (section [0152], [0153]).

As to claim 7, Braud discloses the claimed “a process name element and a message set element” (section [0152], [0153]).

As to claim 8, Braud discloses the claimed “wherein the fault transformer output element includes a message text element” (section [0152], [0153]).

As to claim 11, Braud discloses the claimed “a plurality of ID cross-reference elements” [0117], [0096].

As to claim 12, Braud discloses the claimed “a plurality of message definition elements” (section [0055]).

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As to claim 13, Braud discloses the claimed “a message code sub-element” ([0055], [0093], [0099]; [0114]).

As to claim 14, Braud discloses the claimed “wherein the list of message text element includes a plurality of message text elements” (section [0152], [0153]).

As to claim 15, Braud discloses the claimed “a plurality of value cross-reference elements” ([0055], [0093], [0099]; [0114]).

As to claim 16, Braud discloses the claimed “a plurality of value cross-reference elements” ([0055], [0093], [0099]; [0114]).

As to claim 17, Braud discloses the claimed “a plurality of message text elements, and a plurality of child message set elements” (section [0152], [0153]).

As to claim 18, Braud discloses the claimed “an activity comment element; an activity duration element; and an activity task description element” ([0055], [0093], [0099]; [0114]).

As to claim 19, Braud discloses the claimed “a plurality of address line elements and an address list of location designator element” (table III).

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As to claim 20, Braud discloses the claimed “ an ID element and an ID type element” ([0055], [0093], [0099]; [0114]).

As to claim 21, Braud discloses the claimed “a list of phone number element, a list of email element and a list of web page element” [0154], [0196].

As to claim 22, Braud discloses the claimed “ wherein the data cleansing type element includes a disable cleansing flag element” ([0055], [0093], [0099]; [0114]).

As to claim 23, discloses the claimed “a payment card type element, a payment card number element, a payment card holder element” financial statement and billing categories ([0132], [0377] (table III)).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 25-45 as best understood by the examiner rejected under 35 U.S.C. 102(e) as being anticipated by Braud et al., (hereinafter "Braud") US publication 2003/0023580.

As to claim 25, Braud discloses a health care system that transfers preumbra enterprise data from a plurality of disparate system to a requestor (section [0004], [0021]). Braud discloses the use of managing enterprise data by converting the content from the message data to enterprise information using the content conversion rules (section [0021]). Braud discloses a data type element that contains an application element ([0049], [0132], [0377] (table III)).

As to claims 27, Braud discloses the claimed "an error type element" an error message is send if no information was selected in response to a user request ([0055], [0093], [0099]; [0114]).

As to claims 28 and 29, Braud discloses the claimed "a plurality of application type elements" four type of translation relates to the application program interface ([0055], [0093], [0099]; [0114]).

As to claim 26, Braud discloses the claimed "an application instance name element" (section [0013], [0092]).

As to claim 30, Braud discloses the claimed "wherein the fault handler output element includes a message text element" (section [0152], [0153]).

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As to claim 31, Braud discloses the claimed “a process name element and a message set element” (section [0152], [0153]).

As to claim 32, Braud discloses the claimed “wherein the fault transformer output element includes a message text element” (section [0152], [0153]).

As to claim 33, Braud discloses the claimed “a plurality of ID cross-reference elements” [0117], [0096].

As to claim 34, Braud discloses the claimed “a plurality of message definition elements” (section [0055]).

As to claim 35, Braud discloses the claimed “a message code sub-element” ([0055], [0093], [0099]; [0114]).

As to claim 36, Braud discloses the claimed “wherein the list of message text element includes a plurality of message text elements” (section [0152], [0153]).

As to claim 37, Braud discloses the claimed “a plurality of value cross-reference elements” ([0055], [0093], [0099]; [0114]).

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As to claim 38, Braud discloses the claimed “a plurality of value cross-reference elements” ([0055], [0093], [0099]; [0114]).

As to claim 39, Braud discloses the claimed “a plurality of message text elements, and a plurality of child message set elements” (section [0152], [0153]).

As to claim 40, Braud discloses the claimed “an activity comment element; an activity duration element; and an activity task description element” ([0055], [0093], [0099]; [0114]).

As to claim 41, Braud discloses the claimed “a plurality of address line elements and an address list of location designator element” (table III).

As to claim 42, Braud discloses the claimed “an ID element and an ID type element” ([0055], [0093], [0099]; [0114]).

As to claim 43, Braud discloses the claimed “a list of phone number element, a list of email element and a list of web page element” [0154], [0196].

As to claim 44, Braud discloses the claimed “wherein the data cleansing type element includes a disable cleansing flag element” ([0055], [0093], [0099]; [0114]).

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As to claim 45, discloses the claimed “a payment card type element, a payment card number element, a payment card holder element” financial statement and billing categories ([0132], [0377] (table III)).

Allowable Subject Matter

10. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Remark

(A). Applicant asserted that Bodamer does not translate a database command to a common intermediate form. The examiner disagrees with the precedent assertion. However, when read and analyzed in the light of the specification, the invention as claimed does not support applicants' assertion. Moreover, the claims do not capture the essence of the invention as argued in applicants' remark page 19. The aforementioned assertions, wherein the translation a database command to a common intermediate form fails to disclose by Bodamer with regard to the invention of claim 1, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. It is important to note, Applicants' assertions are not explicitly stated in neither of the independent claim1 nor dependent claims 2-24. There is no mentioned of a translation a database command to a common intermediate form in the claims. In contrast, claim 1 recites “converting the enterprise information in the first form into a second intermediate form”. However, Applicants are interpreting the claims very narrow using the specification without considering the broad teaching of the reference stated in the rejection. Applicants cannot rely on the specification to impart to the claims limitations not recited therein. Such reliance is

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ineffective to define over the prior art. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Winklans, 188 USPQ 129 (CCPA 1975). Applicant is further reminded of the clear difference between reading the claims in light of the specification as allowed by 35 U.S.C. 112, 6th paragraph, and by In re Donaldson 29 USPQ2d, 1845, 16 F.3d 1189 (Fed. Cir, 1994), and reading limitations of the specification into the claims In re Prater 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). Moreover, The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater 162 USPQ 541, 550-51 (CCPA 1969).

Thus, for the above reasons, it is believed that the rejection under 35 U.S.C. 103 provides substantial evidence to support the rationale statement in the above rejection, and the rejection under 35 U.S.C. 103 should be sustained.

(B). Applicant asserted that claim 25 as amended, is not anticipated nor made obvious by the cited references. The examiner disagrees with this assertion. Braud teaches the limitations of claim 25 as broadly claimed. Claim 25 does not produce a concrete and useful result. The proprietary message protocol as disclosed by Braud arrive to the claimed feature as stated in claim 25. In particular, Braud discloses a health care system that transfers preumbra enterprise data from a plurality of disparate system to a requestor (section [0004], [0021]). Braud discloses the use of managing enterprise data by converting the content from the message data to enterprise information using the content conversion rules (section [0021]).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

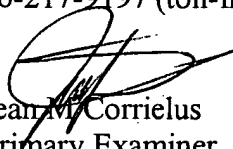
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M. Corrielus
Primary Examiner
Art Unit 2162

November 11, 2005